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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,009	08/10/2001	Kenneth Gabriel Heiser	HEISE R - 01	7281
7590	05/20/2005		EXAMINER	
Albert T. Keyack 1005 Glendevon Drive Ambler, PA 19002			HAILU, TADESSE	
			ART UNIT	PAPER NUMBER
			2173	
			DATE MAILED: 05/20/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/928,009	KENNETH GABRIEL HEISER	

  

<b>Examiner</b>	<b>Art Unit</b>
Tadesse Hailu	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 09 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-7,9 and 10 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7,9 and 10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All . b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This Office Action is in response to the AMENDMENT entered on March 9, 2005 for the patent application (09/928,009) filed on 10 August 2001.

### ***Status of the claims***

2. The pending claims 1-7, and 9-10 are examined herein as follows:

### ***Specification***

3. The disclosure is objected to because it contains a plurality of embedded hyperlinks and/or other form of browser-executable codes. Applicant is required to delete the embedded hyperlinks and/or other form of browser-executable codes disclosed in the BACKGROUND OF THE INVENTION section. The disclosed URLs should be replaced with a relative document name that is not browser-executable, or delete the URL of the document. See MPEP § 608.01.

4. The amendment filed on June 22, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The Brief Description of The Drawings of Figs. 2-5 is the added material which is NOT supported by the original disclosure. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of input

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screens, and the three levels of interactions must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

6. The amendment filed on June 22, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figs. 2-5 is the added material which is NOT supported by the original disclosure. Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Objections***

7. Claim 1 is objected to because of the following informalities: claim 1 recites "...an initial screen for selecting **as** between " (emphasis added), in line 4, "as" should be removed, or appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 5-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The above claims recite "software program" in a process claim, but the "software program" is not positively executed by a computer. Thus, the claims are non-statutory as not being tangibly embodied in a manner so as to be executable. Furthermore, since the claimed "software program" is not embodied in computer readable medium, it is just a descriptive material *per se* and is not statutory because it is neither physical "thing" nor statutory processes. Such claimed "software

program" does not define any structural and functional interrelationships between the "software program" and other claimed aspects of the invention, such as "a first level", "a second level" and "a third level" of interactions, which permit the software program's functionality to be realized.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-4, and 7-10 are rejected under 35 U.S.C. 102(a) as being anticipated by *The Will Expert*, July 30, 2001.

The present invention is directed to generating an interactive will or trust document using the Internet. Similarly, *The Will Expert* discloses an online Last Will and Testament interactive form to be filled by a user (testator). Consequently, *The Will Expert* anticipates the following claimed invention.

With regard to claim 1:

*The Will Expert* discloses a method for enabling a user (testator) to create a will document online. The method includes a plurality of data entry field screens that are arranged in logical order, that is, the first data entry field screen requires personal information, and the second and subsequent data entry field screens deals with financial related matters. Initially, the *Will Expert* presents the user a selectable choice (i.e., click here) if the user is married, and another option (i.e., get started Now) button.

The *Will Expert* then determines and furnishes the corresponding screen based on the user input. In regard to level of complexities, for example, the user who click married link (click here) will fill/answer a question form which differs than question form of a single user (i.e., a user who click get started now button) (for example, as illustrated in each of the forms, the *Will Expert* shows a *simple form* when a user is not married (i.e., user clicks *get started now* button). If the user clicks the marriage link, he may have to furnish information about his/her spouse, which is there will be more entry field to fill. Another example, in regard to level of complexities, the Will Expert also provides the user (testator) a plurality of selectable options during creating the will, for example such as whether his will include Testamentary Trust or not (*The Will Expert*, Page 4). If the user is including a Testamentary Trust in the will, then there will be additional (complex) data entry field to be filled by the user. Furthermore after user inputting data information to each required fields of each screen, then user is able to create and print his own Last Will and Testament document (page 1).

With regard to claim 2:

*The Will Expert* also illustrates (last pages) that user is not allowed to jump to another data entry field screen without completing the current screen inputs. For example the pop-up dialog informs the user to input data to all the fields before proceeding to the next screen (see the screen shots in the last pages).

With regard to claim 3:

*The Will Expert* also provides the user (testator) a plurality of selectable options during creating the will, for example such as whether his will include Testamentary Trust

or not (*The Will Expert*, Page 4). If the user is including a Testamentary Trust in the will, then there will be additional (complex) data entry field to be filled by the user. The entry field is less than the personal data entry field.

With regard to claim 4:

*The Will Expert* discloses a personal data entry field screen, a financial data entry field screen and price data entry field screen for using the software program. Those can be considered as three level of process to create the document.

With regard to claim 7:

*The Will Expert* discloses a method for enabling a user (testator) to create a will document online.

Initially, the *Will Expert* presents the user a selectable choice (i.e., click here) if the user is married, and another option (i.e., get started Now) button. The *Will Expert* then determines and furnishes the corresponding screen based on the user input. In regard to level of complexities, for example, the user who click married link (click here) will fill a question form which differs than question form of a single user (i.e., a user who click get started now button) (for example, as illustrated in each of the forms, the *Will Expert shows a simple form* when a user is not married (i.e., user clicks *get started now* button). If the user clicks the marriage link, he may have to furnish information about his/her spouse, which is there will be more entry field to fill. Another example, in regard to level of complexities, the Will Expert also provides the user (testator) a plurality of selectable options during creating the will, for example such as whether his will include Testamentary Trust or not (*The Will Expert*, Page 4). If the user is including

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a Testamentary Trust in the will, then there will be additional (complex) data entry field to be filled by the user. Furthermore after user inputting data information to each required fields of each screen, then user is able to create and print his own Last Will and Testament document (page 1).

*The Will Expert* also includes a plurality of data entry questions to collect personal and financial data, and processing said data to calculate net worth and other parameters relevant to a will, and furthermore, *The Will Expert* process the data for final output, which is a will document, printable by a user (*The Will Expert*, page 1).

With regard to claim 9:

*The Will Expert* discloses a personal data entry field screen, a financial data entry field screen and price data entry field screen for using the software program. Those can be considered as three level of process to create the document.

With regard to claim 10:

*The Will Expert* also illustrates (last pages) that user is not allowed to jump to another screen without completing the current screen inputs, that is, null input is not allowed. For example the pop-up dialog informs the user to input data to all the fields before proceeding to the next screen (see the screen shots in the last pages).

***Allowable Subject Matter***

10. Claims 5 and 6 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.
12. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu  
Patent Examiner  
Art Unit 2173  
5/10/05

